

REMARKS

Applicants would like to thank the Examiner for careful consideration in the pending application.

Claims 1 and 3-10 are pending in the present application. Claims 1, 4-7, and 10 have been amended. Claim 2 has been cancelled. Support for all amendments can be found in the specification as originally filed. No new matter has been added.

REJECTIONS UNDER 35 USC 112***Second paragraph***

Claim 6 stands rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as the invention.

Applicants have amended claim 6 to attend to the Examiner's rejection. Withdrawal of this rejection is respectfully requested.

REJECTIONS UNDER 35 USC 102

Claims 1-4, 8 and 9 stand rejected under 35 USC 102(b) as being fully anticipated by EP0677246, Tateishi et al. (hereinafter referred to as "Tateishi").

It is well settled that in order for a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in prior art. The disclosure requirement under 35 USC 102 presupposes knowledge of one skilled in art of claimed invention, but such presumed knowledge does not grant license to read into prior art reference teachings that are not there. *See Motorola Inc. v. Interdigital Technology Corp.* 43 USPQ2d 1481 (1997 CAFC).

Tateishi discloses fungicidal compositions designed to target microorganisms having resistance to benzimidazole fungicides containing compounds including

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benomyl, cypendazole, carbendazim, EBC, thiabendazole, fuberidazole, dimethbenzazol, thiophanate methyl, and thiophanate with ipconazole.

Applicants have removed benzimidazole from the list of fungicidal compounds recited in independent Claim 1. Therefore, the fungicidally active compounds in b) of amended independent Claim 1 now includes "metal salts or metal oxides, sulphamides, triazoles, imidazoles, morpholine derivatives, benzothiazoles, isothiazolinones, thiocyanates, quaternary ammonium compounds and guanidines, iodine derivatives, phenols, pyridines, methoxyacrylates and quinolines". Accordingly, amended independent Claim 1 is believed to be in condition for allowance as Tateishi fails to teach or suggest the active compound mixture recited in amended independent claim 1.

Applicants respectfully request reconsideration of the Examiner's rejection of amended independent Claim 1.

Dependent Claims 3, 4, 8 and 9 either directly or indirectly depend from and add further limitations to amended independent Claim 1, and are deemed allowable for at least the same reason in connection with amended independent Claim 1.

Reconsideration is respectfully requested.

Claims 1-10 stand rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 6,369,090, Schelberger et al. (hereinafter referred to as "Schelberger").

Schelberger discloses a "synergistic mixture" including three active components: a.1) a carbamate or the oxime ether carboximide, b.2) a morpholine derivative, and c.3) an azole fungicide that is useful for controlling harmful fungi.

Schelberger inherently teaches against combinations that do not contain each of compounds I, II and III and therefore cannot anticipate amended independent Claims 1, 5, 7 and 10 since this combination of compounds has synergistic activity. Schelberger repeatedly refers to the disclosed combination as a "synergistic mixture" or having synergistic activity (column 9, line 63; column 10, line 3; column 10, line 8; column 12, line 57; column 13, line 52) and teaches that mixtures of compounds I, II, and III have improved "activity spectrum" (column 10, line 9). Schelberger goes on to state that "we

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have found better control of harmful fungi is possible by applying the compounds I, II, and III simultaneously, that is either together or separately, or by applying the compounds I, II, and III in succession than when the individual compounds are used" (column 10, lines 12-16). One skilled in the art would understand a synergistic mixture as having activity greater than the sum of the constituent compounds and that a synergistic mixture necessarily must contain each and every component to maintain synergistic activity.

Therefore, Schelberger inherently teaches against combinations of compounds that do not contain each and every component disclosed. Amended independent Claims 1, 5, 7 and 10 describe a combination containing only 2 components, ipconazole and a fungicidally active compound, and cannot and does not claim the synergistic mixture of the 3 components described in Schelberger.

Accordingly, Schelberger teaches against the currently claimed invention and does not anticipate amended independent Claims 1, 5, 7 and 10. Reconsideration is respectfully requested.

Dependent Claims 3, 4, 6, 8 and 9 either directly or indirectly depend from and add further limitations to amended independent Claims 1 and 5, and are deemed allowable for at least the same reason in connection with amended independent Claims 1 and 5. Reconsideration is respectfully requested.

REJECTIONS UNDER 35 USC 103

Claims 5-7 and 10 stand rejected under 35 USC 103(a) as unpatentable over Tateishi in view of EP0341954, Arahira et al. (hereinafter referred to as "Arahira").

It is well-settled that to establish a *prima facie* case of obviousness, the USPTO must satisfy all of the following requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references. *ProMold v. Great Lakes Plastics*, 37

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USPQ2d 1626, 1630 (Fed. Cir. 1996); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Second, the proposed modification must have had a reasonable expectation of success, as determined from the vantage point of one of ordinary skill in the art at the time the invention was made. *Amgen v. Chugai Pharmaceutical Co.* 18 USPQ 2d 1016, 1023 (Fed Cir, 1991), *cert. denied* 502 U.S. 856 (1991). Third, the prior art reference or combination of references must teach or suggest all of the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496, (CCPA 1970).

Tateishi, as discussed hereinabove, is directed to the protection of crops against microorganism attack does not teach or suggest the intended use of applying the fungicidal composition to industrial materials including wood, wood-based materials, plastics, cooling lubricants and coating systems, such as paints, varnishes or plaster.

Arahira discloses the use of biocidal compositions containing an azole derivative for preventing deterioration of industrial materials including paper, lumber, leather, paints, plastics, metals and inorganic materials and products formed by these materials.

The Examiner believes that it would be obvious to one of ordinary skill in the art to combine the teachings of Tateishi and Arahira to produce the present claimed invention. Applicants respectfully disagree.

Tateishi cannot be considered analogous art for the rejection under 35 USC 103. As previously stated, Tateishi is directed to "a fungicidal composition for agriculture and horticulture use" (See Abstract, line 1). One of ordinary skill in the art would understand that the application of microbicides to plants and industrial materials are quite different, and compositions suitable for protecting crops usually cannot be used for combating microorganisms that attack technical materials and vice versa since the microorganisms that attack living plants are generally different from those that attack non-living materials.

Furthermore, a microbicide suitable for protecting plants has to fulfill different requirements compared with microbicides suitable for protecting technical materials. For instance, a microbicide for use in agriculture applications must be effective at

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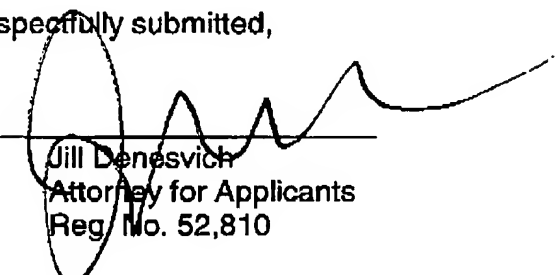
physiological Ph, biodegradable, and, most importantly, not have herbicidal activity for either the plant to which the microbicide is applied or other vegetation. Microbicides for use on technical material do not have these restrictions. Therefore, a skilled artisan would not be motivated to look to the teachings of Tateishi to develop a microbicide for use on technical material.

Accordingly, one skilled in the art would not be motivated to combine the teachings of Tateishi with the teachings of Arahira. Reconsideration is respectfully requested.

Dependent Claim 6 depends from and adds further limitation to amended independent Claim 5 and is deemed allowable for at least the same reasons in connection with amended independent Claim 5. Reconsideration is respectfully requested.

In view of the foregoing amendments and remarks, Applicants believe the pending application is in condition for allowance. Reconsideration and allowance are respectfully requested.

Respectfully submitted,

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